

REMARKS

Amendments

Claim 1 is amended to incorporate the feature recited in original claim 7. As a result, claims 6 and 7 are cancelled.

Claims 2-5, 8-10 and 12 are amended to delete superfluous language and to use language in accordance with conventional US practice. In addition, "use" claim 11 is amended to be a method claim. These amendments do not narrow the scope of the claims.

New claims 13-41 are directed to further aspects of applicants' invention. These claims are supported throughout the disclosure. See, e.g., page 7, lines 28-31; page 9, lines 5-17; page 10, lines 1-28; page 11, line 33 – page 12, line 11; page 16, lines 9-20; page 17, lines 12-16; page 17, line 35 – page 18, line 3; page 23, lines 5-10; and the examples. New claim 41 is an independent claim corresponding to original claim 1, except for the definition of group Y.

Claim Objections

Claim 4 is amended to change "M" to "m," and claim 9 is amended to delete "ir." Withdrawal of the objections is respectfully requested.

Rejections under 35 USC §112, second paragraph, and 35 USC §101

As mentioned above, claim 11 is amended to be a "method" claim, rather than a "use" claim. Withdrawal of the rejections is respectfully requested.

Rejection Under 35 USC §102 in view of EP 0 446 911

This rejection was not applied against claim 7. Thus, the amendment to claim 1 whereby the recitation of claim 7 is incorporated renders this rejection moot. Withdrawal of the rejection is respectfully requested.

Rejection Under 35 USC §102 in view of EP 0 738 709

This rejection was also not applied against claim 7. Thus, the amendment to claim 1 whereby the recitation of claim 7 is incorporated renders this rejection moot. Withdrawal of

the rejection is respectfully requested.

In the rejection, reference is made to compounds 340 and 352 at page 101 of EP '709 and compound 389 at page 103 of the EP '709. See also compounds 276 and 377 at pages 96 and 103. None of these specific compounds nor any of the compounds of formula I of EP '709 anticipate Applicants' claim 2. See, e.g., the left-hand wing group of formula I of '709 which is a hydroxyalkyl or an alkoxyalkyl group.

Rejection Under 35 USC §103 in view of EP 0 738 709

Claims 1-12 are rejected as allegedly being obvious in view of Kondo et al. (EP '709). This rejection is respectfully traversed.

EP '709 discloses ester derivative liquid crystal compounds (see formula 1 of EP '709). EP '709 further discloses liquid crystal compositions containing these ester derivatives in combination with other compounds, i.e., compounds of formulas 2-9. See page 4 of '709.

The possible number of liquid crystalline composition embodiments encompassed by the disclosure of '709 is seemingly infinite. For example, the broad genus of formula I encompasses many subgeneric groups. See, e.g., subformulas 1-1 to 1-24 of pages 11-12 of EP '709. As for the additional compounds that can be present in the liquid crystal composition, see the long list of subformulas at pages 20-34 of the specification. Within this vast grouping of compositional species, there is no suggestion or motivation provided by the disclosure of EP '709 which would lead one of ordinary skill in the art to select, from all of these many possibilities, a composition in accordance with Applicants' claimed invention.

At pages 36-75 of EP '709, the disclosure presents no fewer than 40 compositional examples. None of these liquid crystalline compositions contain a compound in accordance with Applicants' formula I.

In the rejection, specific reference is made to certain subformulas of formula 1 presented at pages 11-12, i.e., subformulas 1-2, 1-10, 1-11, 1-17, 1-19, and 1-24. Comparing these subformulas and the 40 compositional examples, one finds that only compounds of subformulas 1-2, 1-10, and 1-17 are found in the composition examples. See composition examples 20, 22, 26, 27, 32, and 38. Yet, as noted above, these compounds are not of Applicants' formula I.

In view of the above remarks, it is respectfully submitted that EP '709 fails to provide sufficient motivation which would lead one of ordinary skill in the art to select from its broad

compositional disclosure a liquid crystalline composition in accordance with Applicants' claimed invention. The mere ability to modify a disclosure does not, in and of itself, establish obviousness. Instead, there must be some motivation which lead one to the embodiment in question. In the instant case, no such motivation exists with regards to the disclosure of EP '709.

Thus, EP '709 fails to render obvious Applicants' claimed invention. Withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

Rejection Under Doctrine of Obviousness-Type Double Patenting

As with the anticipation rejections, this rejection was also not applied against claim 7. Thus, the amendment to claim 1 whereby the recitation of claim 7 is incorporated renders this rejection moot. Withdrawal of the rejection is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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